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APPLICATION NO. 08/386,813	FILING DATE 02/05/98	HUGLUND FIRST NAMED INVENTOR	5	381427-2000	ATTORNEY DOCKET NO.
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D3M1/0108

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NOLD, C EXAMINER

1215
ART UNIT PAPER NUMBER

01/08/98

DATE MAILED:

#13

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

08/386,813
Faxed to David Rubin
Fax 212 351-3131

From
Examiner Nold
(703) 308-4416

Office Action Summary

Application No.
08/386,813

Applicant(s)
Hoglund et al

Examiner
Charles R. Nold

Group Art Unit
1315



☒ Responsive to communication(s) filed on paper no. 12, 10-27-97

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 13-28 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 13-28 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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Part III DETAILED ACTION

1. Applicant submitted a paper no. 12, 10-27-97 which was a petition under 37 C.F.R. 1.129(a) which was granted. The paper stated that applicant intended to submit comments in the coming weeks substantitively addressing the concerns raised in the final action. No such paper has been received by the PTO.

2. A review of the status of the current claims by the Examiner reveals the following:

a. The parent application SN 07/730,972 is at the board of appeals. The rejection in that application was reversed by the Board on 11-27-97. The Examiner does not have that application in hand at the instant time to make an evaluation of how the status of that application reflects on the instant claims.

b. A new rejection under 35 USC 112 second paragraph is made with respect to claims 26-28.

c. The rejections set forth in the final rejection, paper no. 8, 10-16-97 stand because there are no further arguments on record.

Claim Rejections - 35 USC § 112

3. Claims 14-28 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point

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out and distinctly claim the subject matter which applicant regards as the invention.

Claim 26 lacks antecedent basis for the term "the method", claims 27 and 28 lack antecedent basis for the term "the tubing".

The claims that recite "small amounts of resins" are unclear because it cannot be determined how much "small amounts of resins in order to achieve elasticity properties substantially similar to one another" encompass; ie what encompass "small" is not clear and what the claim intends the value of "substantially similar to one another" is not clear. Claim 26 is unclear because there is no antecedent basis for "the viscose", "the die", "the one surface".

Applicant will please note that these identical rejections were set forth in the first office action as applied to the first set of claims 1-10, now cancelled.

4. Claims 13-28 are rejected under 35 U.S.C. § 112, first paragraph, as the disclosure is enabling only for claims limited to including that the gap between the lips of the die, both upwards and downwards in the cylindrical disposition with the formed tube of paper and the face of the supporting metal ring or cylinder is fixed at .5-.7 , this is disclosed as critical on page 12. See M.P.E.P. §§ 706.03(n) and 706.03(z).

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Applicant will please note that these identical rejections were set forth in the first office action as applied to the first set of claims 1-10, now cancelled.

5. The rejection of claims 1-6 and 10 under 35 U.S.C. § 103 as being unpatentable over applicants admission of prior art is withdrawn due to applicant arguments.

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

7. Claims 13-28 are rejected under 35 U.S.C. § 103 as being unpatentable over Underwood alone or alternatively in view of Smith. Underwood discloses a method of manufacturing porous

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paper webs made from manilla hemp fibers, col. 1, lines 26-27.

The process discloses a cellulose casing having embedded therein the prebonded paper web, in the form of a tube, suitable for stuffing pieces of beef, pork and ham, col. 2, lines 6-14.

Applicants method steps are completely disclosed in col. 1, lines to col. 2, line 4. The method steps taught in the above cited section include (1) forming a paper into a tube, col. 1, lines 51-54, (2) impregnating the tube with viscose, col. 1, lines 58-62, (3) treating the tube with one or more acid or salt baths, col. 1, lines 62-70 to regenerate the cellulose. A plasticizer of glycerol is disclosed in col. 1, line 71. Underwood fails to disclose applicants claimed air dry weight of the manilla hemp fiber being no more than 15 g/m², 13 g/m² or between 12-14 g/m² or a tubing diameter of 165 mm. Applicants claimed tubing diameter of 165 mm would have been an obvious design choice for a diameter of a sausage casing to produce a tubing which would have sufficient commercial applicability and success. It would have been obvious to one having ordinary skill in the art to claim a manilla hemp fiber of from 12-15 g/m² because there is economic incentive to reduce the basis weight of the casing. Reduction of casing thickness is also desirable as it allows production of a shirred product having a higher shir density. Alternatively the secondary reference Smith, US 2,105,273 teaches the use of

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"extremely attenuated and porous" papers as preferable, col. 5, lines 30-31. This teaching would suggest to one having ordinary skill in the art to use as light a paper as possible to provide the benefit of semi-transparency or translucency as disclosed in Smith in col. 5, lines 39-40.

Response to Amendment

8. Applicant's arguments filed 7/5/96 have been fully considered but they are not deemed to be persuasive. Applicant argues that the rejection is improper for "a number of reasons".

Applicant argues against the Examiners motivational statement (economic incentive) by stating that the "economic incentive in the context of this invention actually weight against obviousness", (p. 11, lines 2-3) and that there was a longstanding inability of those skilled in the art to achieve that goal is evidence of nonobviousness of the invention, and further cites the age of the Smith patent and Underwood, and then further argues commercial success. In response to Applicant's argument based upon the age of the references, contentions that the reference patents are old is not impressive absent a showing that the art tried and failed to solve the same problem notwithstanding its presumed knowledge of the references. *In re*

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Neal, 179 USPQ 56 (CCPA 1973). This is on point to applicants arguments because applicant has not shown that there was a "longstanding inability of those skilled in the art" to achieve applicants goal of using light weight paper. Applicants commercial success argument is not persuasive as it is unsupported.

Applicant's claimed unexpected results showing smooth casings are not persuasive because it is the position of the Examiner that where a fibrous casing is thinner and allowed to plasticize the surface would expectedly be smoother, and thus there is really no "unexpected" results.

Conclusion

CRN 1/5/98

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 C.F.R. § 1.136(a).

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE-MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 C.F.R. § 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX MONTHS FROM THE DATE OF THIS FINAL ACTION.

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CRYSTAL MALL 1 FAX CENTER

A facsimile center has been established in Crystal Mall 1, room 8D10. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. the telecopier number for accessing the facsimile machine is (703) 305-5436. This new location should be used in all instances when faxing any correspondence to Examiner Charles R. Nold, Art Unit 1315. The faxing of all papers must conform with the notice published in the Official Gazette, 1096 O.G. 30, November 15, 1989.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Examiner Charles R. Nold whose telephone number is (703) 308-4416.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-2351.


Charles R. Nold
Primary Examiner
Group 1300

crn
January 5, 1998